REMARKS

Claims 2-13 are pending. Claim 2 is hereby amended to correct a typographical error. No new matter has been added by this amendment.

Claim 2 is amended to delete the hyphen in the next to last line thereof.

Interview Summary

Applicant's attorney thanks the Examiner for the personal interview granted April 20, 2006. The art of record was reviewed with the Examiner and distinguished as not showing a batten as recited in the pending claims. More particularly, the art was discussed and claims distinguished, as set forth below in this response to the Office Action mailed April 10, 2006.

Oath/Declaration

A new oath/declaration was required for each inventor to identify the inventor's residence and mailing address. A new declaration in compliance with this requirement was filed with the Office on April 7, 2006. As a result, withdrawal of this objection is respectfully requested.

Claim Objections

Claim 2 was objected to for having a typographical error "plies-extending," and for failing to include an underline for the "," in line 7 of claim 2. The later formality was corrected in Applicant's Amendment of April 7, 2006. This Amendment provides correction for the

typographical error "plies-extending" such that the phrase now correctly reads "plies extending." As a result, withdrawal of these objections is respectfully requested.

35 U.S.C. § 102(b)

Claims 2-11 and 13 are rejected under 35 U.S.C. § 102(b) as being anticipated by Morris (U.S. 5,304,095). Applicant respectfully traverses the rejection of claims 2-11 and 13.

Applicant respectfully submits that Morris '095 does not anticipate claims 2 or 3 as all of the limitations of the claims are not taught or suggested by Morris '095.

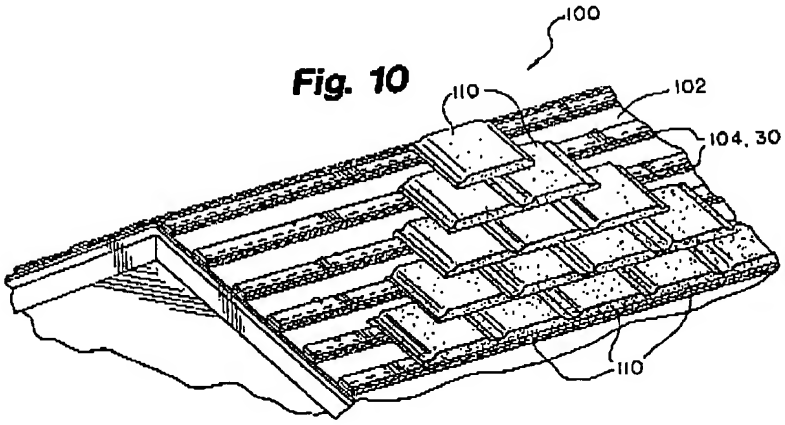
In order for a reference to anticipate an invention, the reference must "describe all of the elements of the claims, arranged as in the patented device." C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1230 (Fed. Cir. 2000). When looking at a reference for anticipation, "[t]he identical invention must be shown in as complete detail as is contained in the patent claim." Richardson v. Suzuki Motor Co., Ltd., 868 F.2d 1226, 1236 (Fed. Cir. 1989). Furthermore, there is "no anticipation 'unless all of the same elements are found in exactly the same situation and united in the same way . . . in a single prior art reference.'" Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 894 (Fed. Cir. 1984).

Morris '095 does not anticipate claims 2 and 3 as it fails to disclose or suggest (1) a "batten," (2) a "tile roof system," or (3) a "batten disposable between the tile and the overlayment," all as recited in each of the pending claims.

The specification of the '193 Patent consistently uses the word batten, and the drawings consistently depict the structure of a batten, in a manner that assumes those skilled in the art

understand a batten to be a support, sized and shaped such that lips or lugs of roof tiles engage the batten for securing the tile along a sloped surface.

This is demonstrated, for example, in Figure 10 of the '193 Patent and the specification at Col. 4, lines 42-57, copied below:



'193 Patent, Figure 10.

> As depicted in FIG. 10, exterior roofing members such as tiles 110, are installed atop battens 30. Thusly installed on a roof, battens 30 function to space tile 110 from the remainder of roof 100 and to drain water which has infiltrated between installed tiles 110, thereby preventing the infiltrated water from pooling atop overlayment 102 and preventing the water from penetrating into the decking and structural members of roof 100. Also as installed on roof 100, channels 58 of battens 30 serve as conduits for air exchange beneath tiles 110, thereby further promoting evaporation of infiltrating water.
>
> Exemplary roof batten 30 may be about 5/8 inches in thickness, 11/2 inches in width, and include two hinged segments 48 inches in length. However, many other dimensions are contemplated to be within the scope of this invention.

'193 Patent, Col. 4, lines 42-57.

In contrast, Morris '095 discloses a "ridge cap type roof ventilator." Morris '095, Col. 1, lines 8-9. As depicted in Figure 1 of Morris '095, for example, a ridge cap roof ventilator is positioned along the peak (ridge) of a roof. The Morris '095 roof ventilator is not sized or shaped such that lips or lugs of roof tiles can engage the ventilator for securing tile along a sloped surface.

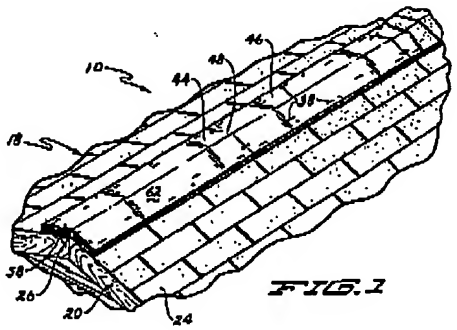


FIG. 1

Morris '095 Patent, Figure 1.

The roof ridge ventilator taught by Morris '095 is for use at the central peak or ridge of the roof to block the opening (16) of the ridge. Morris '095 Patent, Col. 2, lines 50-55; Figs. 1, and 6-7. The Morris '095 roof ventilator is not a batten. The issue of internal ventilation addressed by such a ventilator is separate from the issue of tile support addressed by a batten. A "roof ventilator" does not, and is not designed to, support tiles along a sloped roof.

Morris '095 states in its Background section that, "[o]nce the line of roof ventilators is installed, they are overlayed with shingles, tar paper, tile, or other roofing material." That statement, however, teaches only that roof ventilators may be covered. It does not teach a "batten" or a "tile roof system," as discussed above.

In short, the Morris '095 roof ventilator is not a "batten," Morris '095 does not teach or suggest a "tile roof system," and does not teach or suggest a "batten disposable between the tile and the overlayment," all as required in claims 2-11 and 13 of the pending case. Accordingly, Applicant respectfully submits that the pending claims are not anticipated by Morris '095, and reconsideration and withdrawal of the rejection of claims 2-11 and 13 under 35 U.S.C. § 102 is respectfully requested.

35 U.S.C. § 103(a)

Claim 12 is rejected under 35 U.S.C. § 103(a) as obvious over Morris (5,304,095), in view of Campbell (U.S. 2,042,586). Applicant respectfully traverses this rejection. Applicant submits that all of the limitations recited in claim 12 are not present in the combination of Morris '095 and Campbell, and the required motivation to modify the disclosure of Morris '095 with the disclosure of Campbell has not been established.[1]

Claim 12 depends indirectly from claim 3. As explained above, Morris '095 fails to disclose or suggest all of the recited limitations of claim 3. Applicant also contends that the thermal insulator disclosed by Campbell also fails to disclose or suggest to a person of ordinary skill in the art a tile roof system, a batten, or use of the insulator with either. Because neither Morris '095 nor Campbell disclose or suggest the recited limitations of claim 3, all the limitations of claim 12 are not taught or suggested.

[1] M.P.E.P. 2143 ("To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations.").

Accordingly, Applicant respectfully submits that claim 12 is not obvious in view of Morris '095 or Campbell, and reconsideration and withdrawal of the rejection of claim 12 under 35 U.S.C. § 103(a) is respectfully requested.

Conclusion

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,

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